

TO: Mail Stop 8 Director of the U.S. Patent & Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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SOLICITOR

AUG 31 2007

In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been
 filed in the U.S. District Court _____ of Northern California on the following ☒ Patents or ☐ Trademarks:

DOCKET NO. CV 07-04338 HRL	DATE FILED 08/22/2007	U.S. DISTRICT COURT 280 South First Street, San Jose, Ca 95113
PLAINTIFF UPEK, INC.		DEFENDANT IDEX ASA, ET AL

PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 7,110,577		(See attached complaint)
2		
3		
4		
5		

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading		
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PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK Richard W. Wicking	(BY) DEPUTY CLERK Tiffany Salinas-Harwell	DATE August 23, 2007
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Copy 1—Upon initiation of action, mail this copy to Commissioner Copy 3—Upon termination of action, mail this copy to Commissioner
 Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner Copy 4—Case file copy

COPY

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RICHARD M. HERRINGTON
U.S. DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

Attorneys for Plaintiff
UPEK, INC.

ADR

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

C07 04338 HRL

UPEK, INC., a Delaware corporation,

Plaintiff,

v.

IDEX ASA,
IDEX AMERICA INC., a Delaware
corporation, and
STIFTELSEN FOR INDUDSTRIELL OG
TEKNISK FORSKNING VED NTH.

Defendants.

COMPLAINT FOR DECLARATORY
JUDGMENT OF NON-
INFRINGEMENT AND INVALIDITY
OF U.S. PATENT NO. 7,110,577

DEMAND FOR JURY TRIAL

Plaintiff UPEK, Inc. ("UPEK"), hereby demands a jury trial, and for its complaint against Defendants IDEX ASA ("IDEX"), IDEX America Inc. ("IDEX AMERICA") and STIFTELSEN FOR INDUDSTRIELL OG TEKNISK FORSKNING VED NTH ("SINTEF") alleges as follows:

NATURE OF THE ACTION

1. This is an action for declaratory relief brought pursuant to the Declaratory Judgment Act, 28 U.S.C. § 2201, and arises under the patent laws of the United States, 35 U.S.C. § 271 *et seq.* This action seeks declaratory relief of non-infringement and invalidity of U.S.

1 Patent No. 7,110,577, entitled "Method and Apparatus For Measuring Structures in a
2 Fingerprint."

3 **JURISDICTION AND VENUE**

4 2. This Court has jurisdiction over this action pursuant to 28 U.S.C. §§ 1331 and
5 1338(a).

6 3. Venue is proper in this District pursuant to 28 U.S.C. §§ 1391(b)-(d) and 1400(b).
7 Plaintiff UPEK is a Delaware corporation with a principal place of business in Emeryville, CA.
8 A substantial part of the events or omissions which give rise to some of the claims occurred at
9 UPEK's principal business in Emeryville, CA. On information and belief, Defendant IDEX is a
10 company incorporated in Norway, with its principal place of business in Fornebu, Norway. On
11 information and belief, IDEX maintains a U.S. sales, marketing and operations office, IDEX
12 America Inc. in Foster City, California. On information and belief, Defendant IDEX AMERICA
13 is a corporation incorporated in Delaware, and maintains a sales, marketing and operations office
14 in Foster City, California. On information and belief, Defendant SINTEF is a foundation
15 incorporated under the laws of Norway, with its principal place of business in Trondheim,
16 Norway.

17 **THE PARTIES**

18 4. Plaintiff UPEK is a Delaware corporation with a principal place of business in
19 Emeryville, California, at 2200 Powell Street, Suite 300, Emeryville, CA 94608, which is in this
20 district. UPEK manufactures and sells fingerprint authentication solutions that can be integrated
21 into a variety of commercial applications, including personal laptop computers.

22 5. On information and belief, Defendant IDEX is a company incorporated in Norway,
23 with its principal place of business in Fornebu, Norway. On information and belief,
24 IDEX supplies fingerprint sensing products globally, including in the United States. On
25 information and belief, IDEX maintains a U.S. sales, marketing and operations office, IDEX
26 America Inc. in Foster City, California.

27 6. On information and belief, Defendant IDEX AMERICA is a corporation
28 incorporated in Delaware, and maintains a sales, marketing and operations office in Foster City,

1 California. On information and belief, IDEX AMERICA supplies fingerprint sensing products in
2 the United States.

3 7. On information and belief, Defendant SINTEF is a foundation incorporated under
4 the laws of Norway, with its principal place of business in Trondheim, Norway.

5 **FACTUAL BACKGROUND**

6 8. UPEK manufactures various fingerprint authentication solutions that can be
7 integrated into a variety of commercial and non-commercial applications.

8 9. On April 20, 2007, Defendants IDEX and SINTEF filed a complaint for patent
9 infringement against UPEK in the United States District Court for the District of Delaware. *See*
10 Exhibit A (*STIFTELSEN FOR INDUDSTRIELL OG TEKNISK FORSKNING VED NTH and*
11 *IDEX ASA v. UPEK, Inc.*, No. 1:07-cv-00214-GMS) (the "4/20/2007 Complaint").

12 10. The complaint alleged that the inventor of U.S. Patent No. 7,110,577 (the "'577
13 patent"), entitled "Method and Apparatus For Measuring Structures in a Fingerprint" had
14 assigned the '577 patent to SINTEF, and that SINTEF had granted IDEX an exclusive license to
15 the '577 patent. *Id.* at ¶7-10.

16 11. The complaint further alleged that UPEK infringed the '577 patent by making,
17 using, offering to sell, selling, and/or importing methods and apparatus embodying the patented
18 invention. *Id.* at ¶11.

19 12. On August 17, 2007, nearly four months after filing, IDEX withdrew its 4/20/2007
20 complaint against UPEK without prejudice.

21 13. In sum, Defendants IDEX and SINTEF have displayed their intention to
22 vigorously enforce their intellectual property rights relating to fingerprint authentication
23 technology. IDEX and SINTEF have specifically alleged UPEK of infringing the '577 patent.

24 14. Consequently, Plaintiff UPEK has a reasonable apprehension of imminent suit for
25 alleged infringement of the '577 patent.

26 **GENERAL ALLEGATIONS**

27 15. Plaintiff UPEK incorporates by reference the allegations of paragraphs 1-14 as
28 though fully set forth herein.

17. Defendants IDEX and SINTEF have alleged that UPEK infringed the '577 patent by making, using, offering to sell, selling, and/or importing methods and apparatus embodying the patented subject matter of the '577 patent. UPEK therefore has a reasonable apprehension that IDEX, IDEX AMERICA, and SINTEF will file a patent infringement suit based on the '577 patent against UPEK.

COUNT I

For Declaratory Judgment of Non-infringement of the '577 Patent

18. Defendant UPEK incorporates by reference the allegations of paragraphs 1-17 as though fully set forth herein.

19. UPEK denies that any of its products infringes or has infringed any valid claim of the '577 patent directly, indirectly, contributorily, or otherwise.

20. Accordingly, UPEK seeks a Declaratory Judgment from this Court pursuant to Federal Rule of Civil Procedure 57 and 28 U.S.C. § 2201, that the '577 patent is not infringed by UPEK.

21. A judicial declaration is necessary and appropriate at this time so that UPEK may ascertain its rights and duties with respect to the manufacture and sale of its products that IDEX and SINTEF has alleged infringe the '577 patent.

COUNT II

For Declaratory Judgment of Invalidity of the '577 Patent

22. Defendant UPEK incorporates by reference the allegations of paragraphs 1-21 as though fully set forth herein.

23. UPEK contends that the '577 patent is invalid for failure to comply with the patent laws of the United States, including, without limitation, the provisions of 35 U.S.C. §§ 101, 102, 103, and 112.

25. A judicial declaration is necessary and appropriate at this time so that UPEK may ascertain its rights and duties with respect to the manufacture and sale of its products that IDEX and SINTEF have alleged infringe the '577 patent.

(Attorney Fees)


27. This case is exceptional as defined under 35 U.S.C. § 285, thereby entitling UPEK to reasonable attorney fees.

WHEREFORE, UPEK respectfully requests that this Court:

B. Enter judgment declaring that the '577 patent is invalid;

D. Order such relief as the Court deems just and equitable.

Dated: August 22, 2007

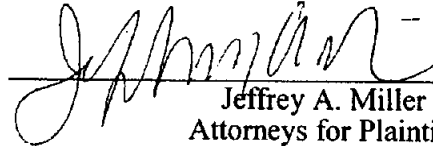

Jeffrey A. Miller
Attorneys for Plaintiff

JURY DEMAND

UPEK demands a trial by jury of all issues so triable.

ORRICK, HERRINGTON & SUTCLIFFE LLP

Dated: August 22, 2007



Jeffrey A. Miller
Attorneys for Plaintiff
UPEK, Inc.

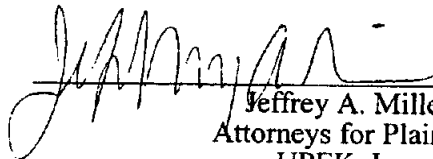
CERTIFICATE OF INTERESTED ENTITIES OR PERSONS

Pursuant to Civil L.R. 3016, the undersigned certifies that the following listed persons, associations of persons, firms, partnerships, corporations (including parent corporations) or other entities (i) have a financial interest in the subject matter of controversy or in a party to the proceeding, or (ii) have a non-financial interest in that subject matter or in a party that could be substantially affected by the outcome of this proceeding:

1. UPEK R&D s.r.o. Subsidiary of UPEK, Inc.
2. UPEK PTE LTD. Subsidiary of UPEK, Inc.
3. UPEK K.K. Subsidiary of UPEK, Inc.

ORRICK, HERRINGTON & SUTCLIFFE LLP

Dated: August 22, 2007



Jeffrey A. Miller
Attorneys for Plaintiff
UPEK, Inc.